UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,941	12/30/2003	Michael Shoen Davis	131713-1	1911

23413 7590 02/27/2006

CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

EXAMINER	
CHEN, VIVIAN	
ART UNIT	**PAPER NUMBER**
1773	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/748,941	DAVIS ET AL.	
	Examiner	Art Unit	
	Vivian Chen	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) *3,4,7,9,10,13 and 40-46* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5,6,8,11,12,14-31 and 36-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/30/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I and Species (a)(2) and (b)(1) and (c)(1) in the reply filed on 12/1/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 3-4, 7, 9-10, 13, 32-35, 40-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and non-elected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/1/2005.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6, 20-21, 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is vague and indefinite because it is unclear if the additionally recited component (SAN) is an integral component of the recited ASA copolymer, or whether the claim refers to a mixture or blend of said two copolymers.

Claim 20 is vague and indefinite because it is unclear if the additionally recited component (polyalkylacrylate) is an integral component of the recited polycarbonate polymer, or whether the claim refers to a mixture or blend of said two polymers.

Claim 39 is vague and indefinite because it is unclear what constitutes a 'class "A" finish'.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6, 8, 11-12, 14-16, 22-29, 36-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-47 of copending Application No. 10/210,746 (US 2003/0175488); or

(b) claims 1-39 of copending Application No. 10/894,952 (US 2006/0019099);

in view of IDEL ET AL (US 4,381,359).

The copending references claim multilayer laminates comprising a resorcinol arylate polyester-carbonate copolymer surface layer, at least one intermediate layer, and an inner layer comprising a blend of polycarbonate and acrylonitrile-styrene-acrylate graft copolymer (ASA),

wherein the laminate is optionally further applied to a thermoplastic or thermoset substrate layer, and other recited features. Features not specifically recited are obvious and/or well known in the art.

IDEL ET AL disclose that it is well known in the art to incorporate a combination of acrylonitrile-styrene-acrylate graft copolymer (ASA) and optionally an additional acrylonitrile-styrene copolymer in polycarbonate compositions in order to obtain improved mechanical properties. (line 40-63, col. 1; line 58, col. 5 to line 7, col. 6; line 32-44, col. 6; line 5-20, col. 7)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize known PC/ASA-based blend compositions in the laminates claimed in the copending applications in order to obtain durable, attractive laminates which can further be used as cladding or surface layers for other substrate materials. It would have been obvious to use commercially available stabilizers (claims 11-12) in order to improve the durability and environmental resistance of the underlying PC/ASA layer. One of ordinary skill in the art would have selected the melt flow properties of the inner layer (claim 14) in order to optimize compatibility in melt processing and multilayer film forming operations. Regarding claims 22, 24-27, the method of forming is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.

Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-6, 8, 11-12, 14-16, 19, 22-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-37 of copending Application No. 10895,522 (US 2006/0017193);

in view of IDEL ET AL (US 4,381,359).

The copending references claim multilayer laminates comprising a resorcinol arylate polyester-carbonate copolymer surface layer, at least one intermediate layer, and an inner layer comprising a blend of polycarbonate and acrylonitrile-styrene-acrylate graft copolymer (ASA), and other recited features. Features not specifically recited are obvious and/or well known in the art.

IDEL ET AL disclose that it is well known in the art to incorporate a combination of acrylonitrile-styrene-acrylate graft copolymer (ASA) and optionally an additional acrylonitrile-styrene copolymer in polycarbonate compositions in order to obtain improved mechanical properties. (line 40-63, col. 1; line 58, col. 5 to line 7, col. 6; line 32-44, col. 6; line 5-20, col. 7)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize known PC/ASA-based blend compositions in the laminates claimed in the copending applications in order to obtain durable, attractive laminates. It would

have been obvious to use commercially available stabilizers (claims 11-12) in order to improve the durability and environmental resistance of the underlying PC/ASA layer. One of ordinary skill in the art would have selected the melt flow properties of the inner layer (claim 14) in order to optimize compatibility in melt processing and multilayer film forming operations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-6, 8, 11-12, 14-31, 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

BRUNELLE ET AL (US 6,306,507) or BRUNELLE ET AL (US 6,265,522);

in view of IDEL ET AL (US 4,381,359).

BRUNELLE ET AL references disclose multilayer laminates comprising a resorcinol arylate polyester-carbonate copolymer surface layer having a typical thickness of 2-2500 microns, at least one intermediate layer (e.g., polycarbonate, polymethylmethacrylate (PMMA), and blends thereof), and an inner layer comprising a blend of polycarbonate and acrylonitrile-styrene-acrylate graft copolymer (ASA), wherein the laminate is optionally further applied to a

thermoplastic or thermoset substrate layer. The laminate is formed by a variety of conventional methods such as coextrusion, and is suitable for automotive components and panels, as well as for forming coated foamed articles.

IDEL ET AL disclose that it is well known in the art to incorporate a combination of acrylonitrile-styrene-acrylate graft copolymer (ASA) and optionally an additional acrylonitrile-styrene copolymer in polycarbonate compositions in order to obtain improved mechanical properties. (line 40-63, col. 1; line 58, col. 5 to line 7, col. 6; line 32-44, col. 6; line 5-20, col. 7) It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize known PC/ASA-based blend compositions in the laminates of the BRUNELLE references in order to obtain durable, attractive laminates which can further be used as cladding or surface layers for other substrate materials. It would have been obvious to use commercially available stabilizers (claims 11-12) in order to improve the durability and environmental resistance of the underlying PC/ASA layer. One of oridinary skill in the art would have selected the melt flow properties of the inner layer (claim 14) in order to optimize compatibility in melt processing and multilayer film forming operations. It would have been obvious to incorporate additional intermediate layers (claim 18) in order to enhance adhesion and/or to obtain specific color or visual effects. One of ordinary skill in the art would have used conventional foam-forming materials such as polyurethane (claim 31) as a substrate in order to obtain useful coated foam articles. Regarding claims 22, 24-27, the method of forming is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does***

not depend on its method of production. If the product in the product-by-process claim is the same or or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 17, 2006

Vivian Chen
Primary Examiner
Art Unit 1773